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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,761	11/09/2001	Daria Mochly-Rosen	58600.8208.US00	3055

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EXAMINER

SNEDDEN, SHERIDAN

ART UNIT PAPER NUMBER

1653

DATE MAILED: 07/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,761

Applicant(s)

MOCHLY-ROSEN ET AL.

Examiner

Sheridan K Snedden

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-58 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 2, 5, 7-9 drawn to the $\delta V1-1$ peptide and derivatives (SEQ ID NO: 4 and 34-64), classified in class 530, subclass 300.
 - II. Claims 1, 3, 7-9 drawn to the $\delta V1-2$ peptide and derivatives (SEQ ID NO: 5 and 65-71), classified in class 530, subclass 300.
 - III. Claims 1, 4, 6, 7-9 drawn to $\psi\delta RACK$ peptide and derivatives (SEQ ID NO: 5 and 11-23), classified in class 530, subclass 300.
 - IV. Claims 1, 7-9, drawn to the $\delta V1-5$ peptide (SEQ ID NO: 7), classified in class 530, subclass 300.
 - V. Claims 10-12, drawn to the $\delta V1-1$ fusion peptides, classified in class 435, subclass 69.7.
 - VI. Claims 10-12, drawn to $\delta V1-2$ fusion peptide, classified in class 435, subclass 69.7.
 - VII. Claims 10-12, drawn to $\psi\delta RACK$ fusion peptide, classified in class 435, subclass 69.7.
 - VIII. Claims 10-12, drawn to $\delta V1-5$ fusion peptide, classified in class 435, subclass 69.7.
 - IX. Claims 13-33, 50-58, drawn to a method of reducing ischemic injury, classified in class 514, subclass 2.

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- X. Claims 34-39, drawn to a method of enhancing ischemic injury, classified in class 514, subclass 2.
- XI. Claims 40-45, drawn to a method of identifying a compound to induce protection of a cell from ischemic damage, classified in class 435, subclass 7.1.
- XII. Claims 46-49, drawn to a method of identifying a compound to enhance damage to a cell from ischemic damage, classified in class 435, subclass 7.1.

2. The inventions are distinct, each from the other because of the following reasons:

Each of inventions I-VIII are directed to patentably distinct and/or independent peptide agonist or antagonists (or use thereof). Absent factual statement/evidence to the contrary, each different peptide sequence and/or polynucleotides sequence encoding same is considered distinct and/or independent, one from the other on the basis of physical, chemical and biological properties and function(s).

The methods of inventions IX-XII require different products and steps and have different endpoints. Therefore, inventions IX-XII are patentably distinct.

Inventions I-VIII is related to invention IX-XII as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the polypeptides of invention I-VIII can be used in a materially different process such as generating antibodies, for example.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II-XII, restriction for examination purposes as indicated is proper.

4. In addition, claims 13-58 of the above inventions IX-XII recites the use of alternative peptides and fusion peptides of Inventions I-VIII. Absent factual statement/evidence to the contrary, each different peptide is considered distinct and/or independent, one from the other on the basis of physical, chemical and biological properties and function(s). As such, The methods recited in the claim each use materially different products. Thus, when any one of the inventions IX through XII are elected under 35 USC 121, an additional election under 35 USC 121 is also required as to the elected peptide product.

Advisory Information

5. A telephone call was made to Judy Mohr on July 14, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheridan K Snedden whose telephone number is (703) 305-4843. The examiner can normally be reached on Monday - Friday, 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-3975 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

SKS
July 17, 2003

SKS


KAREN COCHRANE CARLSON, PH.D
PRIMARY EXAMINER